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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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| IN RE APPLICATION OF | : |
| CHRISTIAN MARZOLIN, ET AL. | : EXAMINER: CHEVALIER, A. A. |
| SERIAL NO: 09/926,367 | : |
| FILED: JUNE 13, 2002 | : GROUP ART UNIT: 1794 |
| FOR: TEXTURED SUBSTRATE CAPABLE OF FORMING A GLAZING, METHOD FOR OBTAINING SAME | : |

REQUEST FOR REHEARING

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following is a Request for Rehearing of the Decision of the Board of Patent Appeals and Interferences (Board) decided June 17, 2009.

The Board affirmed the Examiner's rejection of Claims 1, 2, 4, 6-10, 15, 17, 18, 27-31 and 61-63 under 35 U.S.C. § 102(e) as anticipated by, and of Claims 5, 11-14 and 16 under 35 U.S.C. § 103(a) as unpatentable over, US 6,352,758 B1 (Huang).

For Claim 1, the Board frames the issue as whether Appellants have shown error in the Examiner's finding that the functional limitation recited in the last clause of Claim 1 is a latent or inherent property of Huang's substrate (Decision at 4). However, Appellants respectfully submit that the Board has framed the issue too narrowly. Rather, the issue is whether Appellants have shown error in the Examiner's finding that Claim 1 is anticipated by Huang, given well-settled precedent that anticipation is a finding of fact. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1676 (Fed. Cir. 1994). While Appellants emphasized this functional

limitation in their Appeal Brief, they have never conceded that Huang discloses all the other limitations in the claims. Indeed, as discussed below, there is a very significant limitation that is neither disclosed nor suggested by Huang which the Board erroneously finds is disclosed by Huang.

In response to Appellants' argument that the substrate of Claim 1 is characterized by the formation and growth of water drops on the whole of its surface (emphasis by the Board), the Board points to the last paragraph on page 9 of the specification herein which the Board finds "describes an embodiment which comprises alternating hydrophobic and hydrophilic surface regions and which therefore corresponds in structure and function to the substrate shown in Figures 1-3 of Huang. Appellants point to nothing in claim 1 which excludes their embodiment described on Specification page 9 or the corresponding embodiment shown in Figure 1 of Huang. Therefore, when claim 1 is given its broadest reasonable interpretation consistent with the Specification, the claim 1 substrate is structurally indistinguishable from Huang's substrate shown in Figures 1-3 as correctly found by the Examiner" (Decision at 7). It is noted also that in its findings of fact, the Board specifically refers to this embodiment disclosed in the specification at page 9, last paragraph (Decision at 5).

It is clear from the above that the Board has assumed that the embodiment disclosed in the specification at page 9, last paragraph, is an embodiment of the **presently-claimed** invention. Indeed, it is not.

The limitation that the substrate be hydrophobic/oleophobic was added to Claim 1 by amendment filed December 1, 2005 to the body of the claim, and, in an effort to stress the importance of this limitation, was also added to the preamble for purposes of emphasis by the amendment filed June 5, 2006. By such amendment, the embodiment described in the specification at page 9, last paragraph was necessarily excluded from the scope of the claims. Indeed, a hydrophobic/oleophobic substrate cannot comprise a hydrophobic relief surface and

a hydrophilic lower surface, as described in the specification at page 9, last paragraph. Thus, it is clear error for the Board to find that giving Claim 1 its broadest reasonable interpretation consistent with the specification, the Claim 1 substrate is structurally indistinguishable from Huang's substrate. Clearly, contrary to the findings by both the Examiner and the Board, the structure of Huang's article is different from, and not suggestive of, the presently-claimed substrate. Indeed, Appellants reiterate that Huang's concept is the opposite of that of the presently-claimed invention, as argued in the Appeal Brief, and as the Board has found was incorrect (Decision at 7).

Regarding Claim 2, Appellants argued in the Reply Brief that a siloxane, which the Examiner indicated in the Examiner's Answer is what Huang discloses, unless in polymeric form, i.e., a polysiloxane, cannot be a silicone, and that the siloxanes listed in Huang are examples of coupling agents, of which the Board can take judicial notice are generally low molecular weight compounds. In its Decision, the Board finds that "Appellants have provided the record before us with no basis whatsoever for the proposition that Huang's teaching of siloxanes as coupling agents fails to satisfy the silicone requirement of claim 2. It follows that Appellants have not shown error in the Examiner's ultimate finding that claim 2 is anticipated by Huang" (Decision at 8). Appellants respectfully submit that this was clear error, as now stated.

It was not until the Examiner's Answer that the Examiner changed her finding from silica being a silicone to a siloxane being a silicone. At that stage of the prosecution, Board rules do not permit submission of evidence not already of record in the application. Since Appellants' argument was based on a notoriously well-known fact of silicon chemistry, and Appellants asked the Board to take judicial notice of this basic fact, how can the Board find that Appellants have provided the record with no basis for finding siloxanes as coupling agents are not silicones?

For all the above reasons, it is respectfully requested that the Board vacate its Decision, and enter a new decision reversing the rejections.

Respectfully submitted,

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MAIER & NEUSTADT, P.C.
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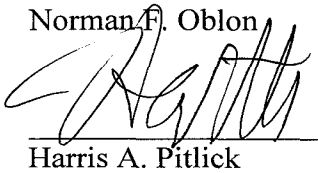

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